

**REMARKS**

**A. The Section 112 Rejections**

Claims 19 and 32 were rejected under 35 U.S.C. §112, first paragraph, the Examiner taking the position that the phrase “that are not grouped” is a negative limitation that does not have basis in the original disclosure. The Applicants disagree and traverse these rejections for at least the following reasons.

Initially, the Applicants note that “[t]he current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph”, *see MPEP 2173.05(i)*.

Further, the fact that the specification does not literally state the negative, namely, that a nearby device is selected from among a plurality nearby devices that are not grouped is not sufficient to establish a *prima facie* case under §112 (*see MPEP 2173.05(i)* and *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993) cited therein). Instead, as long as the original specification reasonably conveys to one skilled in the art that a nearby device is selected from nearby devices that are not grouped, the claims satisfy §112.

Turning to the specification, on page 6, beginning on line 11, the specification explains how a user may select a device in accordance with one embodiment of the claimed invention:

“When no more response signals are received as detected at processing segment 32, the microprocessor 13 queries the GPS receiver 17 at segment 34 and determines the location of each electronic device 20 that responded relative to the location of electronic device 10 at segment 35. The microprocessor 13 then illustrates each other electronic device 20 as an icon corresponding to the device type of each other device 20 on the display 14 arranged according to their relative locations and altitudes to electronic device 10 at segment 36. If the area displayed is too

large, the user can set the maximum distance that an electronic device 20 can be from the user and still be displayed. At this point, the user can select an electronic device 20 to communicate with at processing segment 37, by, for example, keyboard, mouse, touch pad input, touch screen, etc. If the user selects a device to communicate with at processing segment 37, the microprocessor 13 begins a communication routine with the selected device and returns to processing segment 37 so that the user can select another electronic device 20.”

It is clear from the above that the nearby device that is selected by a user is selected from nearby devices that have not been grouped either before or during the selection.

Similarly, after each device is located it is individually arranged on a display without first being grouped.

Still further, another indication that the claimed devices are not grouped is the fact that if an individual device is too far from a user then it will not be displayed because the user has the option of setting the maximum distance that a device can be from the user and still be displayed. In contrast, if the device were part of a group then the specification would necessarily have to address whether the entire group cannot be displayed if an individual device within the group is too far from a user. The fact that the specification does not address such a scenario is an indication that the nearby devices are not grouped.

In sum, the Applicants submit that one of ordinary skill in the art upon reading the claims and the specification would indeed conclude that the inventors had possession of the claimed invention, namely, methods and devices for selecting a nearby device, from among a plurality of nearby devices that are not grouped, at the time the instant application was filed.

Accordingly, Applicants request withdrawal of the rejections and allowance of claims 19 and 32.

**B. The Section 103 Rejections**

**(i) The combination of Fumarolo and Bork does not suggest the claimed inventions**

Claims 3-5, 19 and 30-37 are rejected under 35 U.S.C. §103(a) based on the combination of U.S. Patent No. 6,204,844 to Fumarolo et al (“Fumarolo”) and U.S. Patent No. 6,246,376 to Bork et al (“Bork”). Applicants respectfully disagree and traverse these rejections for at least the following reasons.

Applicants note that claims 4 and 36 have been cancelled.

Of the rejected claims, claims 19 and 32 are independent claims. It is to these claims that the Applicants now turn, it being understood that the remarks which follow apply to the remaining dependent claims.

Each of the claims of the present invention includes the features of a method or device for selecting a nearby device, from among a plurality of nearby devices that are not grouped, to communicate with, comprising the steps of: (a) detecting a plurality of Bluetooth signals from nearby devices that are not grouped, each signal containing GPS coordinates of at least one nearby device; and (b) selecting one of the nearby devices that are not grouped associated with one of the detected signals to communicate with based on the received GPS coordinates.

As the Applicants understand the §103 rejections, the Examiner is relying on Fumarolo for all the features of the claims except the disclosure of a Bluetooth signal. The Examiner relies on Bork for the disclosure of a Bluetooth signal.

Applicants note that Fumarolo does not disclose features (a) and (b) set forth above. Instead, Fumarolo explicitly discloses the grouping of devices into “talk groups”. More particularly, Fumarolo appears to select a group of devices or an individual device that have/has been grouped according to GPS co-ordinates. This is inopposite to the claimed invention.

Further, while Fumarolo discusses the display or depiction of

“representations of the communication units 105-113” (citing column 5, lines 38-39) in Figures 3 and 4 (e.g., an automobile or a radio/walkie-talkie) it does not discuss or otherwise suggest that detected Bluetooth signals from each of the communication units contains GPS coordinates and a device type of the unit. Instead, it appears that a user in Fumarolo inputs the device type into a terminal 101, 201 which includes a display.

In the Office Action the Examiner argues that Fumarolo discloses “selecting a device from devices that have not been grouped” (page 4 of Office Action). Applicants disagree.

What Fumarolo discloses is that after a device or user has indicated the “talkgroup” the device is to be a part of, the device is then grouped into such a talkgroup. Only after such grouping may a user then select just one of the devices from the group (see column 3, lines 25-59) to communicate with.

Said another way the “selection” the Examiner appears to be referring to is a step in forming the talkgroups not a step used to communicate with a device.

The Examiner also takes the position that because the phrase “have not been grouped” is in the preamble the Examiner need not give it patentable weight. This is incorrect.

As the Examiner knows well all phrases in a claim must be considered in judging the patentability of the claim against the prior art (see for example, *In re Wilson*, 65 USPQ 494,496 (CCPA 1970)).

In particular, when phrases in the preamble give “life, meaning, and vitality” to the claim they must be considered, *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F3d. 1298, 1305, 51 USPQ2d 1161,1165-66 (Fed . Cir. 1999).

Here, the phrase “have not been grouped” in the preamble describes the “nearby devices” mentioned, not only in the preamble, but in the body of claims 19 and 32. Thus, the phrase “have not been grouped” gives life, meaning and vitality to the phrase “nearby devices” in the body of claims 19 and 32 and, therefore, must be given patentable weight.

Yet further, when phrases in a preamble are relied upon to distinguish the claimed invention from the prior art these phrases must be considered (see for example, *Bristol-Meyers Squibb Co. v. Ben Venue Labs, Inc.* 246 F.2d 1368, 1375, 58 USPQ2d, 1508,1513 (Fed. Cir. 2001).

Finally, without waiving any past, present or future position the Applicants may have, to expedite examination the Applicants have amended claims 19 and 32 to indicate that the detection and selection steps also include the feature of nearby devices that are not grouped.

Accordingly, the Applicants submit that the Examiner's failure to give patentable weight to the phrase "have not been grouped" is impermissible.

When properly interpreted the Applicants submit that the subject matter of claims 3, 5, 19, 30-35 and 37 would not have been obvious to one of ordinary skill in the art at the time the instant application was filed based on the combined disclosures of Fumarolo and Bork.

**(ii) The combination of Fumarolo and Bork is improper**

As set forth in Applicants' initial response, and reiterated here, the Applicants submit that one of ordinary skill in the art would realize that the particular Bluetooth based system in Bork could not be used in the system of Fumarolo because such a Bluetooth system would most likely not have the distance or range needed to carry out the principle of operation of Fumarolo.

Bluetooth systems provide short range communications (see Bork, column 1, lines 44-47) of approximately 100 meters (Bork, column 1, lines 51-52).

In contrast, the principle of operation in Fumarolo requires a signal to travel distances outside the range of a Bluetooth signal, as in the case where communication units belonging to a number of different agencies (i.e. fire department, police department, ambulance) must be grouped together, especially when the individuals operating such units are enroute to an incident (e.g. accident, fire).

In the Board of Patent Appeals & Interferences decision dated August 24,

2009, in supporting the Examiner's position, the Board states that both "Fumarolo and Bork disclose utilizing group communications in a limited geographic area such as several streets or a shopping mall" (Decision at page 7). However, the claims are directed at specific Bluetooth signals not generalized communications or signals within a limited geographic distance or within a shopping mall. Further, it is well known that Bluetooth signals do not propagate over several streets.

In the Office Action the Examiner takes the position that, in sum, if the Applicants disagree with the Board's decision the Applicants should appeal the decision. Other than this position, the Examiner does not provide a substantive response to Applicants' arguments.

As the Examiner is readily aware, the Applicants have amended the claims since the Board's decision. Thus, the improper combination of Fumarolo and Bork is not the only issue now presented in this application; if it were, then the Applicants may have appealed the Board's decision.

Accordingly, the Applicants maintain that the combination of Fumarolo and Bork is improper for at least the reasons set forth above.

The Applicants respectfully request withdrawal of the pending rejections and allowance of claims 3, 5, 19, 30-35 and 37.

Should there be any outstanding matters that need to be resolved in the present application the Examiner is respectfully requested to contact John E. Curtin at the telephone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3777 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

**CAPITOL PATENT & TRADEMARK LAW FIRM, PLLC.**

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